

## **REMARKS**

### **Status of Claims**

Claims 1-27 are pending in the application. Claims 1-3 and 16-27 are withdrawn from consideration. Claims 4-15 are rejected.

### **Claim Amendment**

Claims 1-3, 8-10 and 14-27 are canceled. Claims 4-6, 11-12 have been amended. A paper copy of the Sequence Listing, a CRF and a Sequence Compliance Statement are included in the present response.

### **Rejections Under 35 USC §112, 2<sup>nd</sup> Paragraph**

Claims 4-15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The rejection is respectfully traversed.

As helpfully suggested by the examiner, claims 4 and 11 have been amended to recite various sequences with SEQ ID NOs. The claims are amended to recite SEQ ID NO:1 encoding the N-terminus (amino acids 1-147) DNA-binding domain of yeast GAL4 protein; SEQ ID NO:2 encoding the basic helix-loop-helix leucine zipper domain of Max; SEQ ID NO:3 encoding the first 11 amino acids of Gal4; SEQ ID

NO:4 encoding the 130 amino acid C-terminus transactivation domain of herpes simplex viral protein VP16; SEQ ID NO:5 encoding the basic helix-loop-helix leucine zipper domain of c-Myc; SEQ ID NO:6 encoding a 17-mer DNA-binding site of Gal4; SEQ ID NO:7 encoding a TET-ON sequence; SEQ ID NO:8 encoding the first 80 bases of the TET-ON sequence; and SEQ ID NO:9 encoding a dominant negative TET-ON sequence.

Applicant submits that no new matter has been added. The amended SEQ ID NOs are used to represent sequences originally disclosed in the application. Applicant further submits that claims 4 and 11 have been amended to particularly point out and distinctly claim the subject matter of the invention. Accordingly, Applicant respectfully requests that the rejection of claims 4-15 under 35 U.S.C. §112, second paragraph, be withdrawn.

Rejections Under 35 USC §112, 1<sup>st</sup> Paragraph, Enablement Rejection

Claims 4-15 are rejected under 35 U.S.C. §112, first paragraph, for lack of enablement. The examiner contends that vectors pRIBS-X and pRIPS-X are required to practice the claimed invention. As a required element it must be known and readily

available to the public or obtainable by a repeatable method. The examine indicates that if the vectors are not so obtainable or available, the enablement requirement of 35 U.S.C. §112, first paragraph, may be satisfied by a deposit of the vectors pRIBS-X and pRIPS-X.

Applicant submits that the specification has provided detailed description on the construction of these vectors. In view of the disclosure and the sequences provided herein, Applicant submits that one of ordinary skill in the art would readily use conventional molecular biology techniques to construct the claimed vectors without undue experimentation. Thus vectors pRIBS-X and pRIPS-X are obtainable by a repeatable method according to genetic engineering techniques well known in the art. Applicant submits that the specification has provided a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact term as to enable any person skilled in the art to make and use the same. Accordingly, Applicant respectfully requests that the rejection of claims 4-15 under 35 U.S.C. §112, first paragraph, be withdrawn.

Rejections Under 35 USC §112, 1<sup>st</sup> Paragraph, Enablement Rejection

Claims 4-15 are rejected under 35 U.S.C. §112, first paragraph, for lack of enablement. The examiner contends that the specification, while being enabling for the administration of vectors pRIBS-X and pRIPS-X to cells *in vitro*, does not reasonably provide enablement for an treatment. The rejection is respectfully traversed.

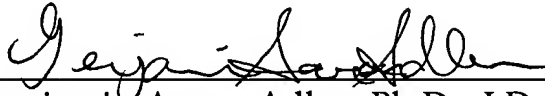
Claims 8-10 and 14-15 have been canceled. The remaining claims are drawn to recombinant expression vector. Specifically, independent claims 4 and 11 are drawn to recombinant vectors pRIBs-X and pRIPs-X. As discussed above, Applicant submits that the specification has provided enabling disclosure for the making and using of vectors pRIBs-X and pRIPs-X. Accordingly, Applicant respectfully requests that the rejection of claims 4-7 and 11-13 under 35 U.S.C. §112, first paragraph, be withdrawn.

This is intended to be a complete response to the Office Action mailed May 6, 2004. If any issues remain outstanding, the examiner is respectfully requested to telephone the undersigned attorney of record for immediate resolution. Applicants enclose herewith a Petition for a Three Month Extension of Time. Please charge the credit card identified on Form PTO-2038 the \$490 extension fee

under 37 C.F.R. 1.17(a). Only in the absence of this form, please debit any fees due from Deposit Account No. 07-1185.

Respectfully submitted,

Date: Nov. 8, 2004

  
Benjamin Aaron Adler, Ph.D., J.D.  
Registration No. 35,423  
Counsel for Applicant

ADLER & ASSOCIATES  
8011 Candle Lane  
Houston, Texas 77071  
(713) 270-5391